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DEBROW, JAMES J

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DANIEL R. MALONE, ALEXANDER K. SCHOWTKA,  
and ROBERT DULANEY

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Appeal 2008-004754  
Application 10/679,028  
Technology Center 2100

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Decided:<sup>1</sup> June 8, 2009

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Before JAMES D. THOMAS, LANCE LEONARD BARRY,  
and JAY P. LUCAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

### STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3-11, and 13. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

### INVENTION

Appellants' invention relates to automated electronic document design systems and methods for designing and modifying product templates. When a user initiates a product design session, a product template is presented for user editing and a product description identifier is assigned to the product being designed. Document templates are assembled from individual composite elements. The individual identifiers of the component elements that make up the template being viewed by the user are associated with the description identifier. Tools are provided to allow a user to change one or more of the composite elements of the template. When a user changes an element, the identifier of the newly selected element is associated with the description identifier. Component elements of one template can be individually used, as appropriate, to prepare customized templates for another part of the same document or for different documents. (Abst., Spec., 18).

## REPRESENTATIVE CLAIMS

Claims 1 and 8 further illustrate the invention, and are reproduced below:

1. A computer-implemented method comprising

receiving a user request to initiate a product design session using a selected template,

in response to the request, associating a product description identifier with a plurality of component element identifiers, each component element identifier identifying a component element of the selected template,

displaying the selected template to the user,

providing one or more tools allowing the user to change at least one component element of the template,

in response to each user change of a component element, associating the element identifier of the new component element with the product description identifier and modifying the displayed template to reflect the change,

using at least some of the element identifiers associated with the product description identifier as element identifiers of a different template, and

displaying the different template to the user.

8. A computer-implemented method comprising

receiving a user request to initiate a product design session using a selected template,

in response to the request, associating a product description identifier with a plurality of component element identifiers, each component element identifier identifying a component element of the selected template,

displaying the selected to the user,

displaying to the user identifiers associated with one or more earlier products associated with the user, and

in response to user selection of one of the earlier product identifiers, associating at least one of the component element identifiers of the selected earlier product with the product description identifier and modifying the displayed template to reflect the change.

#### PRIOR ART AND EXAMINER'S REJECTION

The Examiner relies upon the following references as evidence of unpatentability:

Friedman	US 2003/0208556 A1	Nov. 6, 2003 (filed Oct. 18, 1999)
Fuwa	US 2005/0102151 A1	May 12, 2005 (filed Dec. 25, 2001)

All claims on appeal, claims 1, 3-11, and 13, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Friedman in view of Fuwa.

### Claim Groupings

According to page 10 of the principal Brief on appeal, Appellants rely for a patentability of independent claim 11 upon those arguments presented for independent claim 1, and for patentability of independent claim 13 based upon arguments presented for independent claim 8. No dependent claim on appeal is argued before us.

### ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Friedman and Fuwa teaches the subject matter of representative independent claims 1 and 8 on appeal?

### FINDINGS OF FACT

1. We reproduce the following paragraphs from Appellants discussion of the admitted prior art at Specification pages 1 and 2:

[0003] To provide an alternative to the above approaches, printing service providers, taking advantage of the capabilities of the Web and modem Web browsers, provide document design services for user's desiring to create customized documents from any computer with Web access at whatever time and place is convenient to the user. These service providers typically provide their customers with the ability to access the service provider's web site, view product templates, and enter information to create a customized markup language document. In a typical Web-based system, editing is usually limited to allowing the user to add, modify and position text and perhaps upload images for incorporation into the product design.

[0004] Pre-designed document templates that can be individually selected and downloaded to assist the user in creating a personalized document in the user's browser are known in the art. Some service providers offer templates having similar designs for a range of products so that an individual or business can design and order different products, such as business cards, letterhead, brochures, presentation folders, and return address labels, that share a common look and style. For each type of product, a number of different templates with various images and design features are provided to offer the user a range of design choices.

[0006] When the user selects a desired template, the information required to render the template is downloaded to the user's computer system along with downloaded software tools that can be employed by the user to create a personalized electronic document. For a two-sided product, such as a folded card, the templates for the front and the inside of the card are usually provided separately with the front being provided for editing first.

2. Fuwa teaches an overall system in Figure 1 which includes a template database 9<sub>b</sub>, a product information database 9<sub>c</sub>, a customer management database 9<sub>e</sub>, an order management database 9<sub>f</sub>, and a handling product database 9<sub>g</sub>. The image data creating portion 8 in Figure 1 shows a preview creating portion 81 and a normal image creating portion 82. Figure 12 and paragraphs [0083-0084] indicate the user's ability to select from a plurality of different products and to select any template for customization.

3. In association with a flowchart Figure 13, a user in Fuwa may desire a preview image for customization of a template selected in Figure 12/15. Figure 14 shows a user or customer information image associated

with the template selected as well as the nature of the variable element identifier selected by the user along with address-type information. Beginning at least with paragraph [0120] through the end of the patent publication, it is made clear that the user has the ability to preview images selected for ordering.

### ANALYSIS

At the outset, we note that the principal Brief on appeal does not argue that the references are not properly combinable within 35 U.S.C. 103. Therefore, we do not cite any governing case law relevant to this statutory section. The thrust of Appellants' arguments is that the combined teachings do not teach the subject matter claimed. We disagree with this view.

Representative independent claims 1 and 8, for example, relate to a "computer-implemented method" which does not necessarily require the steps in the body of these claims to be performed by a computer. The actual recitations of the steps themselves alleged not to be present are permitted to be exercised by the user's normal usage of the computerized order taking systems of Friedman and Fuwa.

Page 6 of the principal Brief admits that three of four alleged features found by the Examiner in Friedman are taught in this reference but disputes the fourth feature. This latter feature relates to the association of an element identifier of a new component element with a product description identifier and the modification of a display template to reflect the change. Appellants



also admit that this modification feature is in Friedman but only generally contests that the association capability is not taught in this reference. The Examiner properly notes at the top page 15 of the Answer that the Appellants' arguments are not specific and no rationale is offered as to why Appellants believe the Examiner is in error. Moreover, from our perspective, Appellants do not contest what the Examiner relies upon in Friedman for the feature.

From our perspective as well, the user is free to associate any element identifiers such as a color or font chosen for any product with any other product and to perform a modification or change of any selected product or identifier within the same or different orders, and the same or different products and their different templates. This relates to the operability by a customer of both Friedman's and Fuwa's systems.

The bottom of page 6 begins of the Brief discussion where Appellants dispute what the Examiner realizes upon Fuwa. The first disputed feature relates to the association of the product description identifier with a plurality of component element identifiers where these component identifiers identify component elements of a selected template. This argument is much like the feature already addressed with respect to Friedman. Still, the user within Fuwa is clearly permitted to perform any association of any product or any template associated with a given product or any different product, including component identifiers such as color or font etc. We do not regard the Examiner's view that a product description identifier is expansive and

arbitrary as correlated to categories of products. Nor do we regard as expansive and arbitrary the Examiner's correlation of a product component element identifier to categories of products as argued at the bottom of page 7 of the principal Brief and at pages 1 and 2 of the Reply Brief. Appellants, in effect, are inviting us to read from the Specification into the claims features that are not recited in the claims, and to give patentable weight to labels attached to data or data structures that are not tangible elements. Based upon the nature of the disclosed and claimed invention, and in view of the applied prior art, the Examiner's views are not considered to be overly expansive but broad and reasonable.

The second feature alleged not to be in Fuwa is the nature of the recitation of different templates and the ability of using at least some of the element identifiers associated with a product description identifiers as element identifiers of a different template. Again, the association or use is clearly within the ability of the user to choose among different products, which encompass the claimed different templates, where both references and their collective teachings indicate the ability to present to the customer choices of different templates for different products or for the same product.

These features as well as the displaying of a different template to a user are clearly known in the art as evidenced by findings of fact 2 and 3 at least as associated with Fuwa.

The association feature argued at pages 8-10 of the principal Brief related to claim 8 essentially has been addressed by our discussion earlier in

this opinion as to the feature of association recited in independent claim 1. Finding of fact 3 clearly indicates to the reader that Fuwa teaches the ability of displaying to the user ordered products.

In contrast to the assertions made at pages 4 and 5 of the Reply Brief, Fuwa does teach displaying to the user identifiers associated with the broadly recited earlier products associated with the user. The ability of Fuwa's system to retain information about past orders, as recognized at the middle of page 4 of the Reply Brief, includes the ability, based upon the password of the user, to call up past orders. Additionally, the association of the broadly recited earlier products associated with the user includes the same or different product within the same time frame of an order being made by the customer. As noted earlier, within Fuwa and Friedman, the user is free to broadly associate features such as color and font as component element identifiers of different products within the same order or the same product with different features within the same order, with one of the orders done earlier in time. The user is free to associate the same or different fonts or colors among the same or different orders.

The features argued not to be in the combination of Friedman and Fuwa appear to have been admitted to be in the prior art according to Appellants' admissions set forth in certain paragraphs within finding of fact 1. The ability to have different products share a common look and style, as noted in paragraph [0004] of the admitted prior art, fall within this finding,

and applies to the use of different templates and the same or different choices of various images and design features available to the customer.

Paragraph [0006] reproduced in finding of fact 1 indicates that the user may select a desired template to which is automatically downloaded software “tools” that the user may utilize to create a personalized electronic document, thereby permitting an association of a selected template with certain tools and user changes that may be effected by the use of these tools.

#### CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that the combination of Friedman and Fuwa teaches the argued features among representative independent claims 1 and 8 on appeal.

#### DECISION

The Examiner’s rejection under 35 U.S.C. § 103 of all claims on appeal, claims 1, 3-11, and 13, is Affirmed. All claims are unpatentable.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIMRED

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